

REMARKS

In the Office Action mailed 3/15/2005, Claims 1-20 were rejected as being obvious over the prior art under 35 U.S.C. § 103. Claims 2-13, 16, 18 and 20 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention.

In response, Applicant has amended several claims in order to overcome the §112 rejection; other claims have been made in view of the Examiner's comments and to further clarify the distinctions between the claimed invention and the prior art.

Applicant respectfully asserts that the claims are now in condition for allowance for the reasons set forth below after a discussion of the disclosures of these references.

K.B. Kaiser, U.S. Patent No. 3,311,023

Kaiser is a "cutter shank tightener." It is a "tool holder having a shank received in the recessed end of a driving spindle." Column 1, lines 8-11. There is no disclosure of a punch design; Kaiser in fact is related to a *rotary* tool (e.g. drill) (*see Claim 1*), and not to a punch. There is no specific disclosure related to the cutter design, but it would certainly be a rotary cutter of some sort. The "shank" (element 10) depicted by Kaiser is a conically-shaped portion of the cutting "bit" that is held within the Kaiser "tool holder" (element 11). There is no disclosure of a separate "mandrel" and "punch" arrangement.

Bingham et al., U.S. Patent No. 5,029,392

Bingham discloses a “two point punch.” Bingham is focused on the punch element itself, and makes no disclosure of any external apparatus (i.e. a mandrel). The Bingham “two point punch” has a lower cutting face “26” and an upper cutting face “34” that are each hemispherical and sloped upwardly from the perimeter towards the centerline of the punch face. At the centerline, the lower and upper cutting faces are interconnected with a vertical surface “38.” The lower cutting face is planar, but the upper cutting face is concave; the result is to form two points at the outer perimeter of the punch at the upper face.

McCutcheon, U.S. Patent No. 3,656,394

McCutcheon is a “punch configuration” defined by “planar surfaces which angle inwardly on opposed edges of the punch face” where [t]he angled planar surfaces terminate on a straight line and are interconnected by a grooved circular surface.” See abstract. There is no disclosure of a “mandrel” or its configuration, including its shape’s relationship to the punch. The punch disclosed by McCutcheon does not have pointed tips, but rather has planar surfaces terminating on a straight line.

Morse, U.S. Patent No. 3,647,310

Morse is a “Universal Hole Saw Arbor.” An arbor, like the device of Kaiser, is for holding the shaft of a rotating cutting tool. Morse fails to disclose a punch or its details, a mandrel or any structural details, nor any punching method or approach.

Patentability of Claims 1, 2, 9, 14 and 16-18

These claims stand rejected as being obvious over Kaiser in view of Bingham under 35 U.S.C. §103(a). Applicant respectfully traverses these rejections for at least the following reasons:

1. These claims recite “punches” and/or a method for “punching;” Kaiser is a design for a rotating tool holder (i.e. an arbor or chuck). Kaiser is, therefore, in a field that is non-analogous to the invention of these claims.

2. The punch disclosed by Bingham does not have a pointed tip (or tips) of Applicant’s claimed invention. The combination, therefore, fails to recite each and every limitation of Applicant’s apparatus claims.

3. Regarding Claim 9, the method claim, nothing in Kaiser or Bingham disclose “a method for creating holes in sheets of material,” that comprises the step of “obtaining a powder-actuated tool comprising a receiver.” Of course there are many other non-disclosed claim limitations, but clearly neither of these (or any of the other cited references) disclose a hole punching method involving the use of a powder-actuated tool.

A prima facie case of obviousness is established only when the Examiner provides:

- (a) one or more references¹
- (b) that were available to the inventor²
- (c) where the reference(s) teach³
- (d) a suggestion to combine or modify the reference(s)⁴

¹ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

² *See In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

(e) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.⁵ If the Examiner fails to produce a prima facie case of unpatentability, "then without more the applicant is entitled to the grant of the patent."⁶

Here, elements (b), (c), (d) and (e) are absent in the Examiner's case because:

Since Kaiser is non-analogous, absent other evidence, there is no cited reason why an person skilled in the art of punches would be aware of Kaiser – there is, therefore, no suggestion to combine Kaiser and Bingham. Furthermore, since neither of the references disclose Applicant's claimed pointed-tip punch design, each and every element of Applicant's claimed invention is not taught by these references. Finally, the lack of any punch method disclosure at all by these references Claim 9's method elements are not all found in these references.

As amended, then, these claims should be allowed.

Patentability of Claims 1-4, 9-11, 14 and 16-20

These claims stand rejected as being obvious over Kaiser in view of McCutcheon under 35 U.S.C. §103(a). Applicant respectfully traverses these rejections for the reasons stated above in regard to Kaiser, as well as at least the following reasons:

³ *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

⁴ *In re Lahu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

⁵ *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 47 USPQ 2d 1027, 1033 (Fed. Cir. 1998).

⁶ *In re Oetiker*, 977 F.2d 1444, 24 USPQ 2d 1444 (Fed. Cir. 1992).

1. The punch disclosed by McCutcheon does not have a pointed tip (or tips) of Applicant's claimed invention. The combination, therefore, fails to recite each and every limitation of Applicant's apparatus claims.

2. Also regarding Claims 9-11, the method claims, nothing in Kaiser or McCutcheon disclose "a method for creating holes in sheets of material," that comprises the step of "obtaining a powder-actuated tool comprising a receiver." Of course there are many other non-disclosed claim limitations, but clearly neither of these (or any of the other cited references) disclose a hole punching method involving the use of a powder-actuated tool.

Here, also, then elements (b), (c), (d) and (e) are absent in the Examiner's case for essentially those reasons stated above in connection with the discussion related to the Kaiser/Bingham rejections, and these grounds for rejection should be withdrawn.

Patentability of Claims 5-13 and 15

These claims stand rejected as being obvious over Kaiser in view of McCutcheon, and further in view of Morse under 35 U.S.C. §103(a). Applicant respectfully traverses these rejections for the reasons stated above in regard to Kaiser and McCutcheon, as well as at least the following reason:

1. Like Kaiser, Morse is a design for a rotating tool holder (i.e. an arbor or chuck). Kaiser is, therefore, in a field that is non-analogous to the invention of these claims, which are drawn to punches.

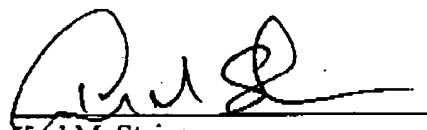
Here, again, elements (b), (c), (d) and (e) are absent in the Examiner's case for essentially those reasons stated above in connection with the discussion related to the Kaiser/Bingham and Kaiser/McCutcheon rejections, and these grounds for rejection should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

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